

## **PCT MAILING**

As part of their review of National Stage Applications, Chapter I Requests, Chapter II Demands, and Substitute Sheets, the PCT paralegals generate various forms which must be mailed. The Tech Centers prepare International Search Reports, Written Opinions, and International Preliminary Examination Reports and return them to PCT for review and mailing. After retrieving work from designated locations, the contractor must process each document type in accordance with the following instructions.

In all instances where the contractor is mailing documents (to applicants or other recipients), the mailing dates stamped on these documents **must** be identical to the meter date which will be applied in the PTO mail center prior to pickup of the mail by the US Post Office. The contractor shall stamp/print the current day's date on the documents if sufficient time remains in the day for another mail center pickup and processing (i.e., metering). If the documents will not be picked up by the mail center until the next day or the mail center will have insufficient time to meter the mail before the end-of-day Post Office pickup, the contractor shall stamp the next day's date on the documents and shall hold the sealed envelopes until the next morning at which time the contractor shall place the envelopes in the mail center pickup location.

### **National Stage Applications**

National Stage Applications are U.S. applications filed under PCT 35 U.S.C. 371. The PCT paralegals will review each application for acceptability, prepare various form letters for mailing, will endorse the content side of the file jacket with the appropriate form letter number(s), and will place the application in the designated pickup location.

After retrieving the files from the designated location(s), the contractor shall use a PALM terminal and click on the PALM Pre-Exam icon then select the "Mail" option from the drop down box. The contractor shall then scan the application bar code label to determine the type of document(s) to be mailed:

- PCT/DO/EO/903 (Notification of Acceptance Of Application Under 35 U.S.C. 371 and 37 CFR 1.494 or 1.495);
- PCT/DO/EO/904 (Notification of Missing or Insufficient Payment of Basic National Fee Required Under 35U.S.C. 371 and 37 C.F.R. 1.494 or 1.495);
- PCT/DO/EO/905 (Notification of Missing Requirements Under 35 U.S.C. 371 in The United States Designated/Elected Office (DO/EO/US));

## **Section J – Attachment 4**

- The contractor must review this form to determine if the box is checked indicating there is an attachment to this form. If the box is checked, the contractor must confirm that the appropriate attachment is present with the form;
- PCT/DO/EO/906 (Notice of Missing Requirements For Obtaining a 35 U.S.C.102.(e) Date);
- PCT/DO/EO/907 (Notice of 35U.S.C. 102(e) Date);
- PCT/DO/EO/908 (Notice of Cancellation of Assigned Serial Number);
- PCT/DO/EO/909 (Notification Of Abandonment),
- PCT/DO/EO/911 (filing of 35 U.S.C. 111 Application);
- PCT/DO/EO/912 (Notice of Insufficient Basic National Fee Required Under 35U.S.C.371 and 37 C.F.R. 1.494 or 1.495);
- PCT/DO/EO/913 (Notice of Defective Translation); and
- PCT/DO/EO/916 (Notification of a Defective Response)

and to update PALM with the date of mailing.

The contractor shall print from PALM Pre-Exam the required number of copies of the form(s) and any attachment(s). Copies of the letter and any attachments are inserted under the right hand clamp in the application file. Copies of the letter and any attachments are inserted into a window mailing envelope with the address clearly visible in the window (the address is printed on each form, any one of which can be used to display the address in the envelope window). The envelope must be securely sealed and placed in the designated location for mail center pickup. The contractor shall record the mailing date next to the entry on the content side of the file jacket.

After endorsing the content side of the file jacket with the mailing date, the contractor shall use a PALM terminal to perform the appropriate PALM dispatch transaction. The contractor will deliver updated applications to the designated location(s):

- PCT/DO/EO/903 = place in designated location for IFW Processing,
- PCT/DO/EO/909 = place in designated location for delivery to Abandoned files,
- All other PCT DO/EO delivered to central files.

### **International Applications**

#### **(Request for) Demand Processing**

A demand is a request for preliminary examination of the application filed under Chapter II of the PCT. The applicant-submitted demand initiates the process which results in an examiner-

#### Section J – Attachment 4

prepared International Preliminary Examination Report (IPER). To prepare an IPER for mailing, the contractor is required to:

- quality check all copies to ensure they are legible and complete, possess images which are distinct and properly centered, and are properly assembled;
- verify that a signature or initials are present in the signature box on the PCT/IPEA/402;
- verify that the mailing address shown in the address box on the PCT/IPEA/402 is the same mailing address printed in the address box on the face of the file; and
- verify that the international application number and the applicant's name on the PCT/IPEA/402 are identical to those on the PCT/IPEA/401.

If any of the required information does not match or is missing, the application must be returned promptly to the Government Representative.

In the "Date of Mailing" box on the front page of any PCT/IPEA/4nn form that is present in the application and is ready for mailing, the contractor shall stamp the mailing date in day/month/year sequence (in accordance with the instructions in paragraph two, above). The contractor will then assemble document sets for mailing in accordance with the following.

- The **original** PCT/IPEA/401, the **original** of the PCT/IPEA/401 fee calculation sheet, and the **original** of the PCT/IPEA/402 are sent to the IB. If there are additional PCT/IPEA/4nn forms, copies of each of the forms should be stapled behind the PCT/IPEA/401 and 402 forms. The **original** of any other document(s) (e.g., power of attorney) which must go to the IB are attached to the back of the package. This bundle of forms is placed in a DHL box for mailing to the IB.
- A **copy** of the PCT/IPEA/401, a **copy** of the PCT/IPEA/401 fee calculation sheet, a **copy** of the PCT/IPEA/402, and a **copy** of any other documents going to the IB must be inserted under the center clamp in the Search Copy file jacket. A **copy** of any additional PCT/IPEA/4nn forms going to the IB are fastened under the right hand clamp in the Search Copy file jacket.
- A **copy** of any PCT/IPEA/4nn forms, **except** the PCT/IPEA/401, along with copies of any other documents sent to the IB are inserted into a window mailing envelope with the applicant's address clearly visible in the window. The sealed envelope(s) are placed in the mail center pickup location.

The contractor will endorse the content side of the file jacket with the mailing date. On the salmon-colored tag (PTO-1557) attached to the file jacket, the contractor must complete the following information:

## Section J – Attachment 4

- Docket Date: Mailing date of the PCT IPEA/402;
- Form 408 (Opinion) Due Date: Calculate 2 months from the PCT/IPEA/402 mailing date.

The (response to the) Opinion Due Date also must be entered on Form PTO-1561 which is located in the center section of the application file.

Using a PALM terminal, the contractor shall activate the PALM EXPO icon and select the “Mail” option. The contractor shall then scan the application bar code label to determine the type of document to be mailed and to update PALM with the date of mailing. After scanning the application bar code label, the contractor will perform one of the following steps as appropriate.

- If there is a PCT/IPEA/402
  - key 5004 and the GAU (Group Art Unit) and scan the application bar code label;
  - forward the application to the appropriate Tech Center.
- If there is a PCT/IPEA/403
  - key 5004 and location code 5100 and scan the application bar code label;
  - forward the application to the appropriate location in PCT.
- If there is a PCT/IPEA/404
  - key 5004 and the GAU (Group Art Unit) and scan the application bar code label;
  - forward the application to the appropriate Tech Center.

### Substitute Sheets

The Government will prepare the various PCT/RO/nnn Forms and associated documents for mailing, complete an instruction sheet identifying the disposition of the copies, insert the forms, documents, and instruction sheet into the appropriate application file, and place the file in the designated pickup location for contractor processing.

After retrieving the applications from the designated location the contractor shall verify that the number of copies made match the number identified on the instruction sheet; quality check each of the copies; check each form for the paralegal’s signature; and date each form with the current date. If an insufficient number of copies are present and/or the quality of any of the documents is unacceptable, the contractor shall return the application to the copy center for correction of the problem. If the paralegal’s signature is missing and/or the mailing instructions are unclear, the application must be returned to the paralegal for correction. After

#### Section J – Attachment 4

determining the application package is acceptable, the contractor shall assemble the documents for mailing in accordance with the following.

- Rubber band or staple together the **original** copy of all forms and all other documents. Place the forms/documents into a commercial delivery service (currently FedEx) box for shipment to the IB.
- Insert a **copy** of all forms and all other documents in the Home Copy file jacket;
  - insert copy(ies) of forms in right hand clamp,
  - insert Power of Attorney papers in center clamp,
  - substitute sheets/drawings
    - remove old drawing(s) or pages from under center clamp of application; stamp "Replaced By RO/US" on upper right hand corner of the first sheet, and insert all sheets under right side clamp,
    - insert the corresponding replacement drawing(s) or pages in the appropriate location under center clamp of application.
    - insert all forms under right clamp of application.
- If an application has a BLUE tag or EP designation in the Group Art Unit Box on front of the application file, rubber band or staple together one set of **copies** of all forms and all other documents and place in a commercial delivery service box for shipment to the EP.
- If an application is a U. S. application (no EP designation or it has a WHITE tag), write "SC" in upper left hand corner of the first sheet and staple one **copy** of all forms and all other documents to the left flap.

After endorsing the content side of the Home Copy file jacket with the date the forms were mailed to the IB, the contractor shall use a PALM terminal to update the PALM system with the mailing date:

- activate PALM EXPO;
- from the drop-down box, select Mail then scan the application number bar code label to load the mail date in PALM; (PALM will automatically enter the current day's date if it's before 2 p.m.; if it's after 2 p.m. the next day's date will be loaded).
- select Dispatch, enter 50CO, and scan the serial number bar code label again.

The updated application shall then be sent to central files for filing.

#### PCT/ISA/220 (International Search Report)

## Section J – Attachment 4

An examiner search report is composed of a Form PCT/ISA/220 and a Form PCT/ISA/210. In each application file to be processed by the contractor, there should be a signed original and up to four copies of the search report with copies of the cited references as appropriate. Normally, reference copies will be provided for inclusion in the application file and mailing to the applicant. Copies for mailing to the EPO and/or the JPO will be present only if required by the paralegal. Reference copies are not mailed to the International Bureau (IB).

The contractor is required to:

- quality check all copies to insure they are legible and complete, possess images which are distinct and properly centered, and are properly assembled;
- verify that the mailing address shown in the address box on the PCT/ISA/220 is the same mailing address printed in the address box on the face of the file jacket;
- verify the international application number and the applicant's name on the PCT/ISA/220 are identical to those on the PCT/RO/101;
- verify the presence of the correct international application number on all pages of the PCT/ISA/210; and
- verify the presence of the appropriate number of copies for all references listed on the PCT/ISA/210 signature page.

If any of the identifying information does not match or is omitted or if references are missing, the application must be returned promptly to the Government Representative.

In accordance with the instructions in paragraph 2, above, the contractor shall stamp the mailing date in the "Date of Mailing" box on the PCT/ISA/220 and in the "Date of Mailing of the International Search Report" box on the signature page of the PCT/ISA/210. The contractor then shall assemble sets for mailing in accordance with the following.

- Insert the **original** copy of all forms in the right hand clamp of the Search Copy (pink) file; place one set of the reference copies in the clamp in the center of the file under the other papers.
- Place one **copy** of all the forms in a commercial delivery service box for shipment to the IB.
- Insert one **copy** of all the forms and a set of reference copies into a piggyback envelope, folding and inserting the PCT/ISA/220 form so the address clearly shows in the envelope window. Securely seal the envelope and place in the designated location for mail center pickup.

#### **Section J – Attachment 4**

- Insert one **copy** of all the forms and, if indicated by the paralegal, the appropriate reference copies into the commercial delivery service box for shipment to the EPO.
- Insert one **copy** of all the forms and, if indicated by the paralegal, the appropriate reference copies into the commercial delivery service box for shipment to the JPO.

After endorsing the content side of the Search Copy file jacket with the mailing date, the contractor shall use a PALM terminal to update the PALM system with the mailing date:

- activate PALM EXPO,
- from the drop-down box, select Mail and scan the application number bar code label to load the mail date in PALM;
- select Dispatch, enter 50CO, and scan the serial number bar-code label a second time.

The updated application shall then be sent to central files for filing.

#### **PCT/IPEA/408 (Written Opinion)**

An examiner's written opinion is contained on a Form PCT/IPEA/408 (cover and followon sheets); cited references copies may also be part of the written opinion. There should be a signed original and one copy of these documents in each application file retrieved by the contractor for processing. The contractor shall:

- quality check all copies to insure they are legible and complete, possess images which are distinct and properly centered, and are properly assembled;
- compare the information on the cover sheet of the PCT/IPEA/408 form with the number of sheets provided for mailing and verify the correct number of sheets are present;
- verify that the mailing address shown in the address box on the PCT/IPEA/408 (coversheet) is the same mailing address printed in the address box on the face of the file jacket;
- verify the international application number and the applicant's name on the PCT/IPEA/408 (coversheet) are identical to those on the PCT/RO/101; and
- verify the presence of the international application number on all pages of the PCT/IPEA/408.

If any of the identifying information does not match or is omitted or if references are missing, the application must be returned promptly to the Government Representative.

#### Section J – Attachment 4

In accordance with the instructions in paragraph 2, above, the contractor shall stamp the mailing date in the “Date of Mailing” box on both the original and the copy of the PCT/IPEA/408 (coversheet). The copies then shall be assembled for mailing in accordance with the following.

- Insert the **original** copy of each document in the right hand clamp of the Search Copy file; place copies of any references cited in the clamp in the center of the file wrapper under the other papers.
- Insert a **copy** of each of the documents into the appropriate size envelope (i.e., piggyback if there are reference copies, legal size, white window envelope if there are not) ensuring the mailing address is visible in the window.

After endorsing the content side of the Search Copy file jacket with the mailing date, the contractor shall use a PALM terminal to update the PALM system with the mailing date

- activate PALM EXPO,
- from the drop-down box, select Mail and scan the application number bar code label to load today’s mail date in PALM,
- select Dispatch, enter 50CO, and scan the serial number bar code label a second time.

The updated application shall then be sent to central files for filing.

#### **PCT/IPEA/409 (International Preliminary Examination Report)**

Form PCT/IPEA/409 is the preliminary examination report rendered by the examiner. A complete International Preliminary Examination Report (IPER) consists of

- Form PCT/IPEA/416 and
- Form PCT/IPEA/409 (coversheet and other appropriate sheets).

There should be a signed original and up to three copies of the documents in each application file retrieved by the contractor for processing. The contractor shall

- quality check all copies to insure they are legible and complete, possess images which are distinct and properly centered, and are properly assembled;
- check the PCT/IPEA/409 coversheet, block 3, to determine the exact number of PCT/IPEA/409 sheets to be mailed;



#### Section J – Attachment 4

- verify that the required number of any references cited on the Form PCT/IPEA/409, Box V, item 2 are present;
- verify that the mailing address shown in the address box on the PCT/IPEA/416 is the same mailing address printed in the address box on the face of the file jacket;
- verify the international application number and the applicant's name on the PCT/IPEA/416 are identical to those on the PCT/RO/101; and
- verify the presence of the international application number on all pages of the PCT/IPEA/409.

If any of the identifying information does not match or is omitted or if references are missing, the application must be returned promptly to the Government Representative.

In addition to the PCT/IPEA/409 sheet(s) to be mailed, there may be “Annexes,” i.e., amended specification, claim, and/or drawing sheets. The Government will have stamped these pages “Amended” and/or “Substitute.” The contractor shall check the PCT/IPEA/409 coversheet, item 2 to determine the exact number of “annexes” to be mailed. If insufficient copies of the required annexes are present, the application should be returned to the Copy Center for additional copying.

In accordance with paragraph 2, above, the contractor shall stamp the mailing date on the original and all copies of Form PCT/IPEA/416 in the “Date of Mailing” box and shall assemble the copies for mailing in accordance with the following.

- Move the original pages being replaced from the center section of the application and insert them in the right hand clamp of the application file. Insert a **copy** of all the pages stamped “amended” and/or “substitute” in the clamp in the center section of the application file; place copies of any cited references in the clamp in the center of the file wrapper under the other papers.
- Insert a **copy** of all the documents into the appropriate size envelope (i.e., piggyback if there are reference copies, legal size, white window envelope if there are not) ensuring the mailing address is clearly visible in the address window.
- Insert the **original** of all documents (excluding any reference copies) into a commercial delivery service box for shipment to the IB.
- Process any additional copies as instructed in cases where there is a special mailing request.

After endorsing the content side of the file jacket with the mailing date, the contractor shall use a PALM terminal to update the PALM system with the mailing date

- activate PALM EXPO,
- from the drop-down box select Mail and scan the application number bar code label to load the mail date in PALM,
- select Dispatch, enter 50CO, and scan the serial number bar-code label a second time.

The updated application shall then be sent to central files for filing.

**Processing Commercial Delivery Service Mailing**

At the end of each day, the contractor will prepare the commercial delivery service (currently FedEx) boxes for mailing. For each box, the contractor must print an address label and a manifest, using the terminal provided for that purpose. After weighing and closing each box, the contractor will affix the appropriate label to each box and will place the box(es) in the designated location for pickup by the DHL courier. The manifest(s) will be delivered to the designated Government Representative.